



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,046	03/05/2002	Peng Chen	P6340 (301101-000009)	6492
28465	7590	11/03/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US LLP			SUBRAMANIAN, NARAYANSWAMY	
P. O. BOX 64807			ART UNIT	PAPER NUMBER
CHICAGO, IL 60664-0807			3624	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,046	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> Narayanswamy Subramanian	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20, 30-34, 36, 51-59 and 64-88 is/are pending in the application.
- 4a) Of the above claim(s) 30-34, 36 and 74-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20, 51-59, 64-73 and 86-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on August 12, 2005. Claims 11-20, 30-34, 36, 51-59 and 64-88 are pending in the application. Claims 30-34, 36 and 74-85 were withdrawn from consideration as discussed in the last office action. Applicants are respectfully advised to cancel the withdrawn claims in response to this office action. Applicant's arguments for withdrawing rejections made under 35 USC § 101 are persuasive and hence these rejections are withdrawn by the examiner. Claims 11-20, 51-59, 64-73 and 86-88 have been examined. The rejections and response to arguments are stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13, 16-20, 55-59 and 64-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 13 and 66 it is not clear how the stored ratio is adjusted between the first time and the second time. It is also not clear if the re-stored ratio is the adjusted stored ratio or the predetermined stored ratio. Claims 16- 8, 55-57 and 69-71 cite the limitations "calculating a case for a probable replacement retirement income", "recalculating additional cases of human capital" and "displaying the results of the calculated cases to an investor". It is not clear what the Applicants mean by the phrases "calculating a case" and "recalculating additional cases". Claims 18, 57 and 71 cite the limitation "using the human capital calculated for the selected case" for which there is no antecedent basis. Claims 19, 58 and 72 cite the

Art Unit: 3624

limitations "determining whether the first portfolio type should still be indicated for the investor given the recommendation of allocation of assets at the second time" and "or whether the investor should be shifted to an adjacent second portfolio type" which are not clear. It is not clear what the Applicant means by "indicating the first portfolio type", "investor should be shifted" and "an adjacent, second portfolio type". Claims 20, 59 and 73 cite the limitation "shifting the investor to the second portfolio type" which is not clear.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-20, 51-59, 64-73 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbox et al (US Patent 2002/0169701) as discussed in paragraph 7 of the last office action mailed on May 12, 2005.

### **Response to Arguments**

6. In response to Applicant's arguments that "the term 'stored ratio' refers to the target allocation of the total worth of an investor between a first and second investment type, which is a predetermined value based upon the investor's human capital", it is not clear as to where in specification a "stored ratio" is defined that way. Applicant is respectfully requested to provide support for this definition in the specification. Also the

Art Unit: 3624

process of adjusting this ratio is not explained in the specification to enable one of ordinary skill in the art to understand the adjustment process.

In response to Applicant's arguments that the term "calculating a case" and "re calculating a case" refer to particular financial scenarios, it is not clear as to what is being calculated. One of ordinary skill in the art can understand "calculating the value of a variable for a particular financial scenario". The language "calculating a case" and "re calculating a case" is indefinite because it is not clear what variable is being calculated for a particular financial scenario.

In response to Applicant's arguments with regard to the limitation "using the human capital calculated for the selected case" cited in claims 18, 57 and 71, the examiner respectfully disagrees with the Applicants. There is no antecedent basis for this limitation because in the independent claims the step of "calculating human capital" is not positively recited.

With respect to the limitations, "determining whether the first portfolio type should still be indicated for the investor given the recommendation of allocation of assets at the second time" and "or whether the investor should be shifted to an adjacent second portfolio type", "indicating the first portfolio type", "investor should be shifted" and "an adjacent, second portfolio type" and "shifting the investor to the second portfolio type", the examiner has carefully studied the cited portions of the specification, but is unable to determine the metes and bounds of these limitations because of lack of clarity in the claim language.

In response to Applicant's arguments about 35 USC § 103 rejection, that Tarbox fails to teach or suggest the inclusion of an investor's current financial worth in

Art Unit: 3624

combination with their human capital, the examiner respectfully disagrees. The last sentence of paragraph 45 discloses "As employees become older, the proportion of Human Capital in total wealth becomes smaller", which clearly implies inclusion of an investor's current financial worth in combination with their human capital to determine the total wealth of an investor. Similar supporting disclosure is provided by the last sentence of paragraph 44.

In response to Applicant's arguments that Tarbox fails to teach or suggest making a target allocation, the examiner respectfully disagrees. In paragraph 66, Tarbox discloses making an allocation based on individual characteristics of participants and a formula established by an Independent expert. This disclosure is interpreted to include making a target allocation.

Applicant's other arguments with respect to the pending claims have been considered but are not persuasive.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the


Art Unit: 3624

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian N.S.  
October 29, 2005

  
Jagdish N. Patel  
Primary Examiner